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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,922	12/19/2000	Dan Vassilovski	990092	4872

23696 7590 06/30/2004

Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,922

Applicant(s)

VASSILOVSKI, DAN

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL DETAILED ACTION

Drawings

1. The amended drawing, see Paper No. 7, still does not correct some of the objections mentioned in the Office Action, see Paper No. 5.
2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the parts numbered: 104, 108, and 112 in Figure 1 as described in the specification in lines 20-22 on page
4. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,477,150 by Maggenti et al, hereinafter Maggenti, in view of U.S. Patent No. 6,360,108 by Rogers.
5. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37

CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claim 1, Maggenti discloses a communication device (CD) in a CDMA system (Figure 2, 202; column 9, lines 61-64; column 10, lines 4-7) operable in at least two states, voice or data (column 6, lines 31-34), a method of inherently transitioning between a call in a first state and a second state or inherently receiving a request for change of state (column 4, lines 9-12; column 9, lines 58-60; column 10, lines 1-4; column 7, lines 48-57), each state inherently having a distinct, associated number (column 10, lines 20-24: a first state which is a voice call can be made by using a dial number: 619-972-6921; and a second state which includes a data service option (e.g. fax) has an associated number: 619-972-9000), each number having a prefix portion (e.g. 619) and a suffix portion (e.g. 972-6921), the call having at least one called party (Figure 2, 204) and a calling party (as shown in Figure 2: 202), the method comprising: requesting a change

of state or change of service option (column 9, lines 53-54); and, inherently, establishing a new call using the number corresponding to the second state (column 14, lines 32-35); and inherently sending the number (including at least the suffix portion) corresponding to the second state to the calling party (column 7, lines 55-57).

Maggenti does not disclose: sending at least the suffix portion of the number corresponding to the second state to the calling party; comparing the number corresponding to the first state with the number corresponding to the second state; and appending the prefix portion of the number corresponding to the first state with the suffix portion of the number corresponding to the second state.

Rogers discloses a method for the automatic prepending of digits in a wireless communication device. A user or calling party enters a destination telephone number into a wireless communication device (see Abstract). The number includes a suffix portion (e.g. 555-1234). The suffix portion of the number corresponds to a state such as, an audio communication or voice state. Selectively enabling the pre-pending of prefixes in a predetermined sequence. For example, the system checks to see if the current number of digits (e.g. 7) corresponds to the expected number of digits for a certain prefix. Appending a prefix portion (e.g. 619) with the suffix portion of the number and establishing a call using the number (e.g. 555-1234) (column 1, line 64 – column 2, line 7; column 7, lines 7-10). Rogers also discloses determining from the location of the wireless device, the prefix required to pre-pend to a telephone number (column 5, lines 49-64). Said wireless device is a cellular telephone that contains a transmitter and receiver to allow transmission and reception of data (column 3, lines 40-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Maggenti to include a method for the automatic pre-pending of digits as taught by Rogers to transition between a first state and a second state. One of ordinary skill in the art would have been lead to make such a modification since establishing a new call includes sending at least the suffix portion of the number corresponding to a voice state to the wireless device, comparing the number corresponding to the voice state with the number corresponding to the expected number of digits, and appending the prefix portion of the number corresponding of the voice state with the suffix portion of the number corresponding to said state. The method of pre-pending of digits to a telephone number can be used for a voice or data state to determine the regional code required for establishment of the call even if the calling party may not know the regional code.

Regarding claim 2, the method as set forth in claim 1 mentioned above, wherein Rogers further discloses comprising storing the number corresponding to the first state in memory associated with the calling party (column 3, lines 32-40).

Regarding claim 3, the method as set forth in claim 1 mentioned above, wherein Maggenti further discloses comprising establishing a call in the first state prior to requesting a change of state (column 7, lines 50-57; column 9, lines 58-60).

Regarding claim 4, the method as set forth in claim 1 mentioned above, wherein Rogers further discloses the prefix portion (e.g. 619) comprises regional codes and the suffix portion (e.g. 555-1234) comprises the telephone number (column 1, lines 38-45).

Regarding claims 5-6, the method as set forth in claim 1 mentioned above, wherein Maggenti further discloses the first state is a clear state and the second state is a secure state or the first state is a secure state and the second state is a clear state (column 5, lines 18-20).

Regarding claims 7-8, the method as set forth in claim 1 mentioned above, wherein Maggenti further discloses the first state is a voice state and the second state is a data state or the first state is a data state and the second state is a voice state (column 4, lines 6-12; column 6, lines 31-32).

Regarding claim 9, the method as set forth in claim 1 mentioned above, wherein Maggenti further discloses the first state is, inherently, a first phone number and the second state is, inherently, a second phone number (column 10, lines 20-24: a first state which is a voice call can be made by using a dial number: 619-972-6921; and a second state which includes a data service option (e.g. fax) has an associated number: 619-972-9000).

Regarding claim 10, the method as set forth in claim 1 mentioned above, wherein Maggenti further discloses the calling party (Figure 2, 202) and the at least one called party (Figure 2, 204) are on a wireless call (column 9, lines 22-25).

Regarding claims 11-20, 21-30, and 31-40, please see the rejection of the method in claims 1-10 above to reject the method in claims 11-20, 21-30, 31-40, respectively.

Regarding claim 41, Maggenti discloses an apparatus (Figure 2, 218) configured to transition between a first state and a second state during a call (column 3, lines 63-65; column 4, lines 9-12), each state inherently having a distinct, associated number (column 10, lines 20-24: a first state which is a voice call can be made by using a dial number: 619-972-6921; and a second state which includes a data service option (e.g. fax) has an associated number: 619-972-9000),

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each number having a prefix portion (e.g. 619) and a suffix portion (e.g. 972-6921), the call having at least one called party (Figure 2, 204) and a calling party (as shown in Figure 2: 202), the apparatus comprising: inherently receiving a request of a change of state (column 7, lines 41-57); and establishing a new call using the number corresponding to the second state (column 6, line 62 – column 7, line 7).

Maggenti does not disclose: a receiver inherently configured to receive a request of a change of state; a comparer configured to compare the number corresponding to the first state with the number corresponding to the second state; a grouper coupled to the comparer configured to append the prefix portion of the number corresponding to the first state with the suffix portion of the number corresponding to the second state; and an establisher configured to establish a new call using the number corresponding to the second state.

Rogers discloses a method for the automatic prepending of digits in a wireless communication device. A user or calling party enters a destination telephone number into a wireless communication device (see Abstract). The number includes a suffix portion (e.g. 555-1234). The suffix portion of the number corresponds to a state such as, an audio communication or voice state. In the prefix storage area, selectively enabling the pre-pending of prefixes in a predetermined sequence (column 5, lines 6-10). For example, the system checks to see if the current number of digits (e.g. 7) corresponds to the expected number of digits for a certain prefix. Appending a prefix portion (e.g. 619) with the suffix portion of the number and establishing a call using the number (e.g. 555-1234) (column 1, line 64 – column 2, line 7; column 7, lines 7-10), by using the 'Enable Auto Prefix' option from an options menu (column 7, lines 41-44). Rogers also discloses determining from the location of the wireless device, the

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prefix required to pre-pend to a telephone number (column 5, lines 49-64). Said wireless device is a cellular telephone that contains a receiver to allow reception of data or a request of a particular state (column 3, lines 40-45). The transmitter is configured to establish a new call using the number corresponding to the voice state (column 4, lines 32-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Maggenti to include a method for the automatic pre-pending of digits as taught by Rogers to transition between a first state and a second state. One of ordinary skill in the art would have been lead to make such a modification since establishing a new call includes components in an apparatus such as: a prefix storage area, 'Enable Auto Prefix' option, transmitter, and receiver to perform the following: sending at least the suffix portion of the number corresponding to a voice state to the wireless device, comparing the number corresponding to the voice state with the number corresponding to the expected number of digits, appending the prefix portion of the number corresponding of the voice state with the suffix portion of the number corresponding to said state, and establishing a call with the telephone number that includes the prefix and suffix. The method of pre-pending of digits to a telephone number can be used for a voice or data state to determine the regional code required for establishment of the call even if the calling party may not know the regional code.

Regarding claim 42, the apparatus set forth in claim 41 mentioned above, wherein Rogers further discloses the receiver is further configured to receive the number corresponding to a state from the calling party (column 3, lines 40-45).

Regarding claim 43, the apparatus set forth in claim 41 mentioned above, wherein Rogers further discloses a storage device or dialed digits storage area, configured to store the

number corresponding to the first state in memory associated with the calling party (Figure 1, 132; column 4, lines 32-37).

Regarding claim 44, the apparatus set forth in claim 41 mentioned above, wherein Rogers further discloses the transmitter is configured to establish a call in the first state or voice state, prior to any change of state (column 4, lines 32-37).

Regarding claims 45-51, please see the rejection of the method in claims 4-10 above to reject the method in claims 42-51, respectively.

Regarding claim 52, please see the rejection of the method in claims 11 and 13 above to reject the method in claim 52.

Regarding claim 53, please see the rejection of the method in claims 11-13 above to reject the method in claim 53.

Regarding claim 54, please see the rejection of the method in claims 41-43 above to reject the method in claim 54.

Regarding claim 55, please see the rejection of the method in claims 41-44 above to reject the method in claim 55.

Response to Arguments

6. In response to the remarks (pages 13-14), of the Amendment filed on April 22, 2004, applicant argues that the Rogers reference fails to teach “comparing the number corresponding to the first state with the number corresponding to the second state” and “appending the prefix portion of the number corresponding to the first state with the suffix portion of the number corresponding to the second state”. The examiner disagrees with applicant. Rogers clearly discloses comparing the number corresponding to the first state or voice state with the number

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corresponding to the expected number of digits and appending the prefix portion of the number corresponding of the voice state with the suffix portion of the number corresponding to said state.

However, Rogers does not teach a first and second state as stated in the claimed invention. The examiner agrees. This feature is addressed in the combination of Maggenti in view of Rogers. That is why it is a 103 rejection (Maggenti in view of Rogers).

Maggenti discloses a communication device (CD) in a CDMA system (Figure 2, 202; column 9, lines 61-64; column 10, lines 4-7) operable in at least two states, voice or data (column 6, lines 31-34), a method of inherently transitioning between a call in a first state and a second state or inherently receiving a request for change of state (column 4, lines 9-12; column 9, lines 58-60; column 10, lines 1-4; column 7, lines 48-57), each state inherently having a distinct, associated number (column 10, lines 20-24: a first state which is a voice call can be made by using a dial number: 619-972-6921; and a second state which includes a data service option (e.g. fax) has an associated number: 619-972-9000), each number having a prefix portion (e.g. 619) and a suffix portion (e.g. 972-6921), the call having at least one called party (Figure 2, 204) and a calling party (as shown in Figure 2: 202), the method comprising: requesting a change of state or change of service option (column 9, lines 53-54); and, inherently, establishing a new call using the number corresponding to the second state (column 14, lines 32-35); and inherently sending the number (including at least the suffix portion) corresponding to the second state to the calling party (column 7, lines 55-57).

There is clearly an incentive to modify the communication device of Maggenti to include comparing numbers and appending prefixes to numbers as that described in Rogers so that the a communication device can operate in two states, voice or data.

In conclusion, the elements of the claimed invention is well met by the cited reference(s) above, please see the rejections and response above.

7. Applicant's arguments with respect to claims 1-55 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

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Or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Or call:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh
June 28, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

